

REMARKS

By this amendment, claims 1-11, 13-22, 24-33, 35-45, and 47-57 are pending, in which claims 12, 23, 34, 46, and 58 are cancelled without prejudice or disclaimer, and claims 1-2, 13, 24, 36-37, and 47-48 are amended. Care was exercised to avoid the introduction of new matter.

The Office Action mailed July 6, 2004 rejected claims 1-9, 13-20, 24-31, 35-43, and 47-55 as obvious under 35 U.S.C. § 103 based on the newly-cited Montpetit et al. (US 6,366,761) in view of Jacobson et al. (US 6,381,250); claims 10, 21, 32, 44, and 56 as obvious over Montpetit et al. and Jacobson et al. further in view of Smith (US 6,498,937); and claims 11-12, 22-23, 33-34, 45-46, and 57-58 as obvious over Montpetit et al. and Jacobson et al. further in view of Courtney et al. (US 6,665,518).

As a preliminary matter, the specification and claims 2, 37, and 48 are amended to correct certain typographical errors.

The rejection of claims 1-11, 13-22, 24-33, 35-45, and 47-57 is respectfully traversed because the applied art, individually or in combination, do not teach or suggest the features of the claim. For example, claims 1 and 47, as amended, recite:

partitioning the system capacity based upon capacity requirements of a plurality of network service providers, a portion of the system capacity being designated as a shared capacity pool among the network service providers and another portion of the system capacity being dedicated to one of the network service providers;

Independent claims 13, 24, and 36, as amended, recite:

wherein the system capacity is partitioned based upon capacity requirements of a plurality of network service providers, a portion of the system capacity being designated as a shared capacity pool among the network service providers and another portion of the system capacity being dedicated to one of the network service providers

In the statement of the rejection regarding claim 12, the Office Action, p. 24, correctly admits that "Montpetit in view of Jacobson does not teach partitioning the system capacity based upon capacity requirements of a plurality of network service providers, a portion of the system capacity being designated as a shared capacity pool." Nevertheless, this feature is not taught in Courtney et al.

Courtney et al. is directed to a technique for asymmetric assignment of space-borne communication system resources (Title), involving "the assignment of uplink and downlink bandwidth in a satellite communication system that accounts for concentrators onboard a satellite" (col. 1:64-66).

Courtney et al., however, does not teach a “a portion of the system capacity being designated as a shared capacity pool among the network service providers” nor “another portion of the system capacity being dedicated to one of the network service providers” as recited in the claims. In fact, Courtney et al. lacks explicit disclosure of network service providers in the first place.

The portions of Courtney et al. cited in the Office Action do not support the rejection. For example, col. 4:21-24 merely states: “Referring again to FIG. 1, the controller 108 preferably makes and modified bandwidth assignments, and may also be used in an initial planning role when developing a new communication system.” This passage lacks the sufficient level of detail to be relevant to the claim language. Column 5:14-16 is also palpably insufficient: “The parameters in Table 1 may originate, for example, from an engineering or marketing study for a new communication system.” The Table 1 parameters involve various ratios and efficiencies of outbound vs. inbound traffic, gateway vs. user, and uplinks vs. downlinks but do not specifically relate to “capacity requirements of a plurality of network service providers” as recited in the independent claims.

The Office Action further reasons that “there can be a market that has more than one network service provider and thus Table 1 can be based on engineering and marketing study for more than one service provider” (p. 24). Yet, in rejecting a claim under 35 U.S.C. § 103, the Patent Office is required to provide a factual basis to support the obviousness conclusion. In re Warner, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967); In re Lunsford, 357 F.2d 385, 148 USPQ 721 (CCPA 1966); In re Freed, 425 F.2d 785, 165 USPQ 570 (CCPA 1970). The Patent Office is required to show that all the claim limitations are taught or suggested by the references. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); In re Wilson, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). Disclosure can be explicit or inherent, but inherent disclosure that the explicitly missing descriptive material be “necessarily present,” not merely probably or possibly present, in the prior art. In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citing Continental Can Co. USA, Inc. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991)).

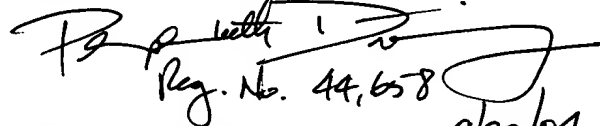
In the present application, the Office Action’s argument that “there can be a market ... and thus Table can be based” (emphasis added) makes it plain that Courtney et al. neither expressly nor inherently discloses the network service providers. Furthermore, even if Courtney et al. or a newly-found reference were to disclose a plurality of network service providers, such a disclosure would still be insufficient by

itself to teach or suggest the features of the claim, including: "a portion of the system capacity being designated as a shared capacity pool among the network service providers" nor "another portion of the system capacity being dedicated to one of the network service providers."

The remaining secondary reference, Smith, does not show the network service providers nor was applied against claim 12 for such a feature.

Favorable consideration of this application is respectfully requested. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at (703) 425-8516 so that such issues may be resolved as expeditiously as possible. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,



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